

REMARKS/ARGUMENTS

The Office Action mailed May 26, 2005, has been received and reviewed. Claims 1 through 13 are currently pending in the application. Claims 6 through 8 and 11 through 13 are withdrawn from consideration. Claims 1 through 5, 9, and 10 stand rejected. Applicant has amended independent claim 1 and respectfully request reconsideration of the application as amended herein.

35 U.S.C. § 102(b) Anticipation Rejections

Anticipation Rejection Based on U.S. Patent No. 3,936,055 to Scott

Claims 1 through 3 and 10 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Scott, U.S. Patent No. 3,936,055. Applicant respectfully traverses this rejection, as hereinafter set forth.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

Applicant respectfully submits that Scott does not describe an apparatus as set forth in independent claim 1 as currently amended. The present invention is directed to an “apparatus configured for use on a golf driving range as a target practice green by a person hitting a ball towards the target practice green from a remote tee area....” Scott does not describe such a target practice green. In contrast, Scott describes a “golf practice stage” suitable for home or office on which a person stands and practices golf swings by hitting balls initially placed on the practice stage. *E.g.*, *Scott*, column 3, lines 11, 18-21. The golf practice stage can be used to practice both fairway shots and for putting. *Id.* at column 3, lines 19, 57. Exactly how someone can practice “fairway” shots on the small device of Scott in a home or office is unexplained by Scott. While Scott does not describe dimensions of the practice stage in particular, Scott teaches “a handle on the frame for carrying of the stage,” which clearly implies that the panels of the stage are sized to allow the stage to be carried by a person which is consistent with “home or office” use.

The small device of Scott is not amenable to use as a target practice green for tee shots from a remote tee, for example, inasmuch as any ball that hit the stage from a remote distance would most certainly bounce or roll off of the stage. For these reasons, applicant respectfully asserts that the golf practice stage described by Scott clearly is not configured for use as a target towards which a person would hit golf balls from a remote tee area. For these reasons, the practice stage described by Scott cannot be considered a target practice green as recited in claim 1 suitable for use at an outdoor driving range. The instant invention is for a practice green apparatus useful at a driving range wherein a golfer drives balls towards the practice green from a remote tee, such is not the Scott device. Therefore, applicant requests reconsideration and allowance of independent claim 1 as currently amended.

35 U.S.C. § 103(a) Obviousness Rejections

Obviousness Rejection Based on U.S. Patent No. 3,936,055 to Scott in view of U.S. Patent No. 5,980,392 to Cox

Claims 4 and 5 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Scott (U.S. Patent No. 3,936,055) in view of Cox (U.S. Patent No. 5,980,392). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

Applicant respectfully asserts that the 35 U.S.C. § 103(a) obviousness rejections of claims 4 and 5 are improper because there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the teachings of Scott with Cox. In fact, the size differential, the difference in purpose and the

method of using each are so disparate that one skilled in the art would not look at one of these patents as a suitable guide for modifying the other.

The Examiner asserts in the outstanding Office Action at page 3 that “it would have been obvious to [one] of ordinary skill in the art to have used such on Scott’s device as well if it was desired to use it for chipping practice.” Applicant respectfully asserts that “[a] statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made, because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a prima facie case of obviousness without some objective reason to combine the teachings of the references.” MPEP § 2143.01 (*citing Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993)). Furthermore, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. MPEP § 2143.01 (*citing In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990)).

As previously discussed herein, Scott does not disclose a target practice green towards which a user hits balls from a remote tee area, but rather a small stage or tee area for office or home use on which a user stands and swings golf clubs at balls initially placed on the stage. Scott does not teach or suggest hitting balls towards the stage from a remote area, e.g. such as that found at a driving range, and the configuration of the stage described in Scott is such that a person would not do so. Furthermore, Cox does not teach using the target practice green described therein as a golf practice stage.

For the above reasons, Applicant respectfully asserts that there is no motivation to combine the cited references and respectfully requests reconsideration and allowance of claims 4 and 5.

Obviousness Rejection Based on U.S. Patent No. 3,936,055 to Scott in view of U.S. Patent No. 5,445,381 to Van Ert

Applicant respectfully asserts that the 35 U.S.C. § 103(a) obviousness rejection of claim 9 is improper because the prior art references do not teach or suggest all the claim limitations. In particular, none of the prior art references teach or suggest vertical support members having

“collapsing means whereby a vehicle may be positioned underneath [the] golf practice green, [the] vertical support members collapsed, thereby lowering [the] golf practice green onto [the] vehicle for transportation over a road.”

Van Ert teaches a putting system that is intended for use indoors. *Van Ert*, column 1, lines 6-9. The putting system includes, among other elements, a putting green 10 and a standing base 12. *Id.* at column 3, lines 28-29. The green includes leg means for independently adjusting the height of the putting surface at each corner. *Id.* at column 4, lines 15-17. Applicant respectfully asserts that the leg means for adjusting the height or slope of the putting surface taught by Van Ert do not allow for a vehicle to be positioned underneath the green.

The indoor device of Van Ert does not provide a suitable combinable reference when one is seeking to create structural solutions to a large green-like apparatus too large to transport on highways in the playable configuration. The structure as claimed in the instant application is markedly different from anything suggested by Van Ert.

For the above reasons, Applicant respectfully asserts that the cited references do not teach or suggest all the claim limitations of claim 9, and respectfully requests reconsideration and allowance thereof.

ENTRY OF AMENDMENTS

The amendment to claim 1 above should be entered by the Examiner because the amendment is supported by the as-filed specification and drawings and does not add any new matter to the application.

CONCLUSION

Claims 1 through 5, 9, and 10 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned agent.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "J. Jeffrey Gunn", followed by a long horizontal line extending to the right.

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